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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/677,829
Filing Date: October 02, 2003
Appellant(s): OGG, CRAIG

R. Ross Viguet
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 22, 2009 appealing from the Office action mailed February 26, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Patents:

6,151,591	Pierce, et al.	11-2000
WO 02/093498	Willoughby, et al.	11-2002

5,742,683	Lee, et al.	3-1998
5,812,400	Eddy, et al.	9-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-18, 20-21, and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce, et al., U.S. Pat. No. 6,151,591 (Reference A of the PTO-892 part of paper no. 20071012) in view of Willoughby, et al., Intl. Pat. Pub. No. WO 02/093498 (Reference N of the PTO-892 part of paper no. 20080910).

As per claim 14, Pierce teaches a method of accessing a remote postage account from a local postage evidencing device, comprising: connecting to a remote postage evidencing system via a local postage evidencing device (col. 5, lines 40-42), said local postage evidencing device having a local postage account (col. 5, lines 40-41); identifying a remote postage account on the remote postage evidencing system that is to be used to print postage on the local postage evidencing device (col. 5, lines 62-63); selecting a desired postage amount to be printed on the local postage evidencing device (col. 7, line 48); reducing a balance on the remote postage account (col. 5, lines 66-67) without transferring the value of the postage amount to the local account, thereby maintaining a same local postage account balance (col. 3, lines 45-50); and printing the desired postage amount on the local postage evidencing device (col. 8, lines 2-4). Although Pierce teaches providing access to a plurality of remote postage accounts (e.g., in Fig. 7), Pierce does not explicitly teach configuring the local postage evidencing device to communicate with a plurality of vendors providing access

to a plurality of remote postage accounts, and that the identified account is administered by a selected vendor of said plurality of vendors; which is taught by Willoughby (§ 0018). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Willoughby so that a user can select another vendor if a particular remote postage provider suffers downtime or exits the industry (as taught by Willoughby; § 0012). Moreover, this is merely a combination of old elements in which each would serve the same function as it did separately, and the addition of this feature to the method disclosed by Pierce could be implemented through routine engineering producing predictable results.

As per claim 15, Pierce in view of Willoughby teaches the method of claim 14 as described above. Pierce further teaches printing the desired postage amount on the local postage evidencing device without reducing a balance on the local postage account (col. 6, lines 4-6).

As per claim 16, Pierce in view of Willoughby teaches the method of claim 14 as described above. Pierce further teaches authenticating a user with the remote postage evidencing system (col. 8, line 50).

As per claim 18, Pierce in view of Willoughby teaches the method of claim 14 as described above. Pierce further teaches connecting to the remote postage evidencing system using a wireline connection (col. 7, line 14).

As per claim 17, Pierce in view of Willoughby teaches the method of claim 14 as described above. Willoughby further teaches connecting to the remote postage evidencing system using a wireless connection (§ 0027). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Willoughby because wireless networks are known alternatives to other communications networks (as taught by Willoughby; § 0027). Moreover, this is merely the simple substitution of a wireless network for the wired network used for the same purpose as disclosed in Pierce, and could be implemented through routine engineering producing predictable results.

As per claim 20, Pierce in view of Willoughby teaches the method of claim 14 as described above. Pierce further teaches the local postage evidencing device is a postage meter (col. 11, line 65).

As per claim 21, Pierce in view of Willoughby teaches the method of claim 20 as described above. Pierce further teaches the local postage account is a register that reflects the amount of postage that is currently authorized on the device (col. 10, lines 60-62).

As per claim 24, Pierce in view of Willoughby teaches the method of claim 14 as described above. Pierce further teaches the local postage evidencing device is a personal computer coupled to a printer (col. 5, lines 24-25).

As per claim 25, Pierce in view of Willoughby teaches the method of claim 24 as described above. Pierce further teaches the local postage account is a stored value of postage that has been downloaded from an Internet-based postage service (col. 2, lines 47-49).

As per claim 26, Pierce in view of Willoughby teaches the method of claim 14 as described above. Pierce further teaches the remote postage account is an Internet-based postage service (col. 3, lines 51-55). Willoughby further teaches that the account is associated with a vendor (§ 0018), which would have been obvious to incorporate for the same reasons stated above with respect to claim 14.

As per claim 27, Pierce in view of Willoughby teaches the method of claim 14 as described above. Willoughby further teaches the remote postage evidencing account comprises a postage account established by the United States Postal Service (§ 0007). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Willoughby because the USPS is the entity responsible for authorizing postage vendors that supply postage to be used in the USPS mail stream (as taught by Willoughby; §§ 0003, 07).

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce, et al. in view of in view of Willoughby, et al. as applied to claim 14 above, further in view

of Lee, et al., U.S. Pat. No. 5,742,683 (Reference C of the PTO-892 part of paper no. 20071012).

As per claim 19, Pierce in view of Willoughby teaches the method of claim 14 as described above. Pierce in view of Willoughby does not teach identifying a user to the local postage evidencing device using a biometric input; which is taught by Lee (col. 8, line 22). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Lee because biometric data is a known manner of securely authenticating users, similar to a password (as taught by Lee; col. 8, lines 17-22). Moreover, this is merely a combination of old elements in which each would serve the same function as it did separately, and the addition of this feature to the method disclosed by Pierce could be implemented through routine engineering producing predictable results.

Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce, et al. in view of Willoughby, et al. as applied to claim 14 above, further in view of Eddy, et al., U.S. Pat. No. 5,812,400 (Reference D of the PTO-892 part of paper no. 20071012).

As per claim 22, Pierce in view of Willoughby teaches the method of claim 14 as described above. Pierce in view of Willoughby does not teach the local postage evidencing device is a postage dispensing kiosk; which is taught by Eddy (col. 3, line 57). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Eddy in order to provide the increased functionality and utility to kiosk meter users (as taught by Eddy; col. 3, lines 57-59). Moreover, this is merely the simple substitution of a kiosk for the terminal device used for the same purpose as disclosed in Pierce, and could be implemented through routine engineering producing predictable results.

As per claim 23, Pierce in view of Willoughby and Eddy teaches the method of claim 22 as described above. Pierce further teaches the local postage account is an amount of postage purchased by a user at the device (col. 5, line 41). Eddy further

teaches the device is a kiosk which would be obvious for the same reasons as in claim 22 above.

(10) Response to Argument

A. Willoughby is sufficient to teach the disputed local postage evidencing device configured to communicate with a plurality of vendors.

Appellant argues that Willoughby is not sufficient to disclose what is relied upon to teach; specifically, "configuring the local postage evidencing device to communicate with a plurality of vendors." It is unclear why a user computer programmed with intermediary software to communicate with vendors cannot be considered the "local postage evidencing device." Appellant appears to be arguing one of the preferred embodiments present in the Specification (e.g., ¶ 0039) wherein the local device connects directly with a vendor, without the use of software tools such as those used in embodiments of Willoughby. However, the claim language is not so narrow. "[A] particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment." *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004). Moreover, the presence of software tools as part of the "configuring" in Willoughby is not sufficient to distinguish the claimed invention, as it still discloses that which is actually set forth in the claim language. During examination the USPTO must give claims their broadest reasonable interpretation in light of the specification. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004). This interpretation is not inconsistent with the preferred embodiment, only broader. Accordingly, Willoughby is sufficient to teach the disputed limitation.

B. Appellant's assertions of incompatibility are not supported by adequate evidence.

Appellant also argues that the systems of Pierce and Willoughby are "divergent," "fundamentally different," and therefore not combinable. Brief, page 8. Examiner

respectfully disagrees and maintains that the combined teachings render the claimed invention unpatentable under § 103(a). Support for Appellant's position is provided by way of various alleged processing conflicts (see Brief, pages 9-10) and citations to Pierce and Willoughby. However, the record does not indicate that the suggested awkward, conflicting combination is the only manner in which to combine the teachings of the references. Additionally, a review of Appellant's citations to the record in the Appeal Brief do not provide sufficient support to conclude these conflicts are fatal to the combination. Arguments of counsel cannot take the place of factually supported objective evidence. *In re Huang*, 100 F.3d 135, 139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984).

Nothing in Pierce's disclosure would make it impossible or even unworkable to add remote vendors. Indeed, remote vendors would be highly desirable in the event that the local meters all run out of funds. The local funds in Pierce must eventually be replenished from somewhere, and the system would derive the same benefits from remote refilling as the system in Willoughby (e.g., ease of use, multiple options for vending postage funds). Examiner acknowledges that the systems disclosed by Pierce and Willoughby would have redundant and potentially interfering elements if the entire system of Willoughby was crudely attached to the networked meters in Pierce by one without any requisite skill. Appellant appears to create such constructions in the Brief, wherein Willoughby's Application Programming Interface (API) subverts certain functionality present in Pierce's system. Brief, pages 8-10.

Appellant argues that without incorporating Willoughby's entire API into Pierce "then there is nothing in the cited references to teach one of skill in the art how to achieve the functionality that is admittedly missing from Pierce." Brief, page 9. A review of the record does not substantiate this assertion. Moreover, the record does not tend to support Appellant's similar assertions that adding Willoughby's API would render Pierce non-functional, despite the supposed "conflicting transaction processing . . . and other conflicts." Brief, page 9. Appellant has submitted no outside evidence in the form of declarations or affidavits supporting the assertion that one skilled in the art would be unable to add remote postage vendors to Pierce's system. Appellant contends that

Pierce's postage value transfer "could not be carried out with the remote accounts in Willoughby because the algorithms of Willoughby would cause the shipping system API to subvert the functionality of the local PSD of Pierce." Brief, page 9. However this factual statement is also unsupported by existing evidence in the record. The finding of the Examiner that this functionality of Willoughby is compatible with Pierce has been disputed solely through Appellant's conjecture and citations to the record that do not tend to support Appellant's factual statements.

Appellant cites *In re Ratti* in support of the argument that Willoughby would change the principle metering operations of Pierce. Brief, page 9, citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). *Ratti* set a two-prong test for incompatibility of prior art references. A combination may be improper: first, if the combination would require a substantial reconstruction and redesign of the prior art; and second, if the combination would change the basic principles under which the prior art was designed to operate. *Id.* at 813, 352. The combination of Pierce and Willoughby satisfies both prongs as a proper combination of prior art references. Substantial design and reconstruction is unnecessary, as both systems use similar hardware and software elements. Both meter postal matter and download postal funds. The only differences are the sources of those funds. Also here, in contrast to *Ratti*, the principles of operation remain the same. Pierce's core principles of downloading postage, decreasing the amounts of the register, and printing postage all remain the same. Again, the only difference is the source of the postage.

The differences in *Ratti* were not on the margins; they were the pillars upon which the Examiner's rejection was based. The court in *Ratti* was not concerned with the minutiae of how a particular designer would create the proffered combination. Rather, it recognized a fundamental difference in operations that would result in an inoperative combination. *Id.* That is not the case here. The Examiner has consistently made findings that the level of skill displayed in the references is such that it would not require significant modification of Pierce's main system to include Willoughby's remote vendors. Moreover, this added functionality would imbue Pierce's system with new and useful features that relate to the same principles and method of operation (i.e., postage

metering and postage accounting) that are the focus of the primary reference; not destroy its ability to function properly and make it a mere paperweight as Appellant seems to suggest.

"When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385, 1396 (2007) (emphasis added). In the instant case, Appellant has not even alleged that the application of a remote vendor feature to Pierce would be beyond the skill of an ordinary artisan, let alone provided convincing evidence to that effect. Rather, Appellant has merely contended that under some imagined assembly the combination would be unworkable. Appellant's position appears to be that such a combination of Pierce and Willoughby's remote vendors is impossible, even assuming extraordinary skill. This position is plainly not supported by adequate evidence on the record and is contraindicated based upon the level of skill displayed in the applied references.

"A person of ordinary skill is also a person of ordinary creativity, not an automaton." *Id.* at 1397. It is well within the boundaries of reasonable skill and engineering to modify the system in Pierce by adding the singular desired functionality in Willoughby to connect to multiple remote postage vendors. When functionality from any two similar but not identical devices are integrated into one system in an attempt to take advantage of both devices' benefits, certain routine engineering tasks are often required to successfully incorporate the desired elements. In the context of a computer-based invention as in the instant claims, this could potentially happen in any number of ways depending upon the design preferences and customary decisions made by the engineer during development of the final system. By way of example, if a software developer wished to add a useful text-entry feature to an existing program after a

pleasant experience using Microsoft Word, the engineer is not likely to sloppily append large portions of word-processing code from Word to the initial program; as this would result in a useless, unexecutable program (i.e., the "misplaced appendage" envisioned in the Brief, page 9). Rather, the typical engineer is more likely to simply construct a module that provides the desired text entry functionality experienced in Word, but will also successfully integrate with the existing program and make it better. However, this routine engineering does not render the resultant program patentable or fulfill the requirements of § 103(a) so long as the developer has only used well-known prior art elements and functions still serving the same purposes, and the combination of these elements yielded no unpredictable results.

Arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Appellant cites to some passages of the cited art in the supplied arguments, but none of the cited passages appear to provide evidence sufficiently germane or supportive of Appellant's assertions of incompatibility. As such, Appellant's proffered examples of combinations that yield the alleged unworkable system cannot be considered adequate evidence to dispute either the Examiner's individual factual findings or the ultimate legal conclusion of obviousness. The level of skill in the art displayed in the cited references is such that Pierce's system could be configured to support the multiple remote vendors described by Willoughby without difficulty and with predictable results. Appellant's arguments have not successfully demonstrated that the findings and rationale used in the rejections above constitute reversible error. Accordingly, they should be affirmed.

C. The reasons for combining the teachings of Pierce and Willoughby are proper.

Appellant also argues that the Office has not provided a plausible reason for combining the teachings of Pierce and Willoughby. Brief, page 11. Examiner respectfully disagrees. Appellant suggests that there would be no need for multiple remote vendors in Pierce because "the system in Pierce does not have a remote vendor that could be suffering downtime" Brief, page 11.

As a threshold matter, this mischaracterizes the disclosure of Pierce. As set forth below in section C., Pierce discloses that local postage evidencing systems can refill from a remote Data Center via an internet connection (see col. 2, lines 46-49). Appellant is correct that in Pierce there are multiple local postage meters in a network that can share funds with one another. However, these funds must initially come from some vendor, and that vendor may be suffering downtime. To compound matters, the networked meters in Pierce will eventually run out of funds with which to share among one another. In at least these instances, Pierce's system would benefit from the multiple remote vendors in the same manner and for the same reasons they are useful in Willoughby.

Moreover, Appellant's claimed invention is merely a combination of old elements in the art of postage metering. In the combination, no element would serve a function other than it already did independently, and one skilled in the art would have recognized that the combination could be implemented through routine engineering producing predictable results. The Supreme Court has held that such instances of a predictable use of prior art elements according to their established functions are obvious. *KSR*, 550 U.S. 398.

D. Pierce in view of Willoughby fully discloses the Internet-based postage service.

Specifically with respect to claim 25, Appellant disputes that Pierce discloses the downloaded postage is from an "Internet-based postage service." Brief, page 12. Rather, Appellant asserts that Pierce simply discloses a generic "network connection to a data center." The cited portion of Pierce discloses: "Connections to a Data Center, for example for registration and refill transactions, are made locally from the Host through a local or modem/internet connection." Pierce, col. 2, lines 46-49 (emphasis added). Any differences between this disclosure and the claim language can solely result from improperly importing limitations from the Specification (as addressed in section A. above). As the Data Center in Pierce discloses a postage download using an internet connection, Examiner maintains that this meets the plain language of the claimed

"Internet-based postage service." The remaining claims are not argued on their own merits, and Examiner submits they stand or fall with the independent claims.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

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